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09/631,301	08/02/2000	Yasunari Kimura	JEL 31225	8435

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Stevens Davis Miller & Mosher LLP
Suite 850
1615 L Street NW
Washington, DC 20036-5622

EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,301

Applicant(s)

KIMURA ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24-25 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/631,301.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Examiner's Note

1. Examiner has pointed out particular references contained in the prior art of record in the body of this Action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to specific limitations within the individual claims, other passages and figures may apply as well. It is requested from the Applicant, in preparing the response, to consider in full the entire references as potentially teaching all or part of the claimed invention, as well as the context of the cited passages of the prior art as disclosed by the Examiner.

Status of Claims

2. Per the Amendment filed under 37 CFR § 1.111 on 24 March 2003:

Claims 1-6 were amended.

Claims 1-6 remain pending.

3. The proposed Supplemental Amendment filed on 25 March 2003 has not been officially entered because it is unsigned. However it was considered and the argument(s) recited therein are responded to below.

Response to Request for Reconsideration

4. The requests for consideration filed on 24 and 25 March 2003 under 37 CFR § 1.111 have been considered but are ineffective to overcome Foladare et al. in view of Walker et al., US Patents No. 5,914,472 and 6,327,348 B1.

Response to Arguments

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5. Applicant's arguments have been fully considered but they are not persuasive.

In regards to claims 1-3 and 5:

The amendments to these claims recite requesting connection to a mobile communication terminal through a mobile communication line. Foladare clearly teaches that the verification of a transaction is done by "two-way communications, e.g., cellular phone, two-way pager, or other personal communication service" (Foladare, Col 3, lines 7-12). It is obvious that in order to connect to a mobile communication device such as a cell phone, the Foladare system inherently has to use a mobile communication line to establish the connection.

Applicant further argues that a "first aspect of the double control feature" comprises sending member information through an "open communication line" to a remotely located database. Here too, Foladare discloses that member information is collected at a merchant site (via swiping a credit/debit card through a card reader) and transmitting the card owner's information to a remote database via local telephone lines (an open communication line) (Foladare: Fig 1, associated text).

Therefore the Foladare system clearly meets and anticipates the further limitation of claims 1-3 and 5.

In regards to claims 3 and 5:

Applicant argues in Supplemental Amendment (not entered) that "an accounting amount" is "registered" in the database wherein once approval of the transaction has been secured, that accounting amount will be deducted from a bank account registered preliminarily. Foladare clearly teaches that spending "limits" are pre-established in a user's account, and that only once authorization is verified will the transaction amount be deducted from such account (Foladare: Fig 2, associated text).

Therefore the Foladare system also clearly meets and anticipates this limitation of claims 3 and 5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al, US Patent No. 5,914,472.

As per claim 1:

Foladare discloses a transaction control/authorization method comprising the steps of:

(a) receiving a member ID information from a user through an open information communication line; (Abstract; Fig 2, related description);

(b) identifying a member by comparing a member ID information registered in a member database and the member ID information from the user (Fig 2, related description);

(c) requesting connection to a mobile communication terminal of the member through a mobile communication line by using a mobile communication terminal number registered in said member data base when the member is identified (Fig 2, steps 210-216, related description); and

(d) judging authentication when an authentication approval signal is received from said mobile communication terminal (Fig 1, steps 116, 120, related description; Col 3, lines 2-33).

Foladare is directed toward controlling access to an account owned by one user when an "ancillary" user is attempting to use the account, either buying a service or product. Foladare teaches how a bank/credit card issuer may "double-check" whether access to a payment account is truly authorized, whether in the absolute, or only up to a certain monetary level, by contacting the account owner and requesting an unequivocal confirmation. It would have been obvious to one ordinarily skilled in the art at the time the invention was made to apply Foladare's invention to an authorization system for credit/debit/charge account transactions where fraud is a high-level concern. Instead of just requiring a confirmation whenever an ancillary user is involved, all transactions will require such a confirmation from the account owner, thus minimizing the risk of

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card/account information loss and their being used for fraudulent transactions or access to services.

As per claim 2:

Based on the same analysis as per claim 1 above, *Foladare* discloses a transaction control/authentication apparatus comprising:

a member database registering an information of members (Figs 2-3, related description; Col 2, lines 53-64);

an individual authentication control means for receiving a member ID information from a user, through an open information communication line (Fig 2, related description);

a basic authentication means for identifying a member by comparing a member ID information registered in said member database and the member ID information received from said individual authentication control means (Fig 2, database 208, and Fig 3, database 224, related description); and

a mobile communication authentication means for requesting connection to a mobile communication terminal of the member through a mobile communication line using a mobile communication terminal number registered in said member data base, when the member ID from the user is authenticated by said basic authentication means (Fig 1, blocks 110,112, 114, related description);

wherein said authentication apparatus judges that the authentication is successful, when receiving an authentication approval signal from said mobile communication terminal (Fig 1, block 116, related description).

As per claim 3:

Based on the same analysis as per claim 1 above, *Foladare* discloses a [accounting] method comprising the steps of:

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receiving a member ID information from a user and an accounting amount relating to a service, through an open information communication line (Fig 1, steps 100,102, related description);

identifying a member by comparing a member ID information registered in a member database and the member ID information from the user (Fig 2, step 104, database 208, and Fig 3, database 224, related description; Col 4, lines 23-35);

requesting connection to a mobile communication terminal of a debtor through a mobile communication line by using a mobile communication terminal number registered in said member data base, when the member is identified (Fig 1, blocks 110,112, 114, related description);

inquiring approval or rejection of a payment of a charge to the debtor (Fig 1, block 114, related description); and

registering the accounting amount in said member database together with an information about service presentation, when receiving a signal approving the payment of the charge by the debtor from said mobile communication terminal, and deducting the accounting amount from a bank account registered preliminarily (Figs 2-3, related description; Col 3, lines 15-33).

As per **claim 4**:

Foladare discloses a method as defined in claim 3 further comprising the step of:

receiving a facility ID information of a facility for the service presentation, through the open information communication line; and identifying the facility . (In Col 3, lines 30-33, Foladare discloses that a merchant name is a component of the information transmitted and used for authorization).

As per **claim 5**:

Based on the same analysis as per claims 1-4 above, *Foladare discloses an apparatus comprising:*

a member database registering an information of members;

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accounting authentication control means for receiving the member ID information from a user and accounting amount relating to a service, through an open information communication line;

basic authentication means for identifying a member by comparing a member ID information registered in said member database and the member ID information received from said accounting authentication control means;

mobile communication authentication means for requesting connection to a mobile communication terminal of a debtor registered in said member database through a mobile communication line, when the member ID from the user is authenticated by said basic authentication means.

Foladare does not specifically disclose a means for deducting the transaction amount from the user's account in his description. However it would have been obvious to one ordinarily skilled in the art at the time the invention was made that such a step would be inherent in maintaining said account up to date at the authorization center, so that the account user may continue to use the account and his balance be carried forward accurately. As a result, the last limitation of claim 5 would be anticipated by *Foladare's* invention, namely:

accounting means for deducting the accounting amount from a bank account registered preliminarily, and registering the accounting amount in the database together with an information about service presentation, when receiving an approval signal for the accounting amount from the mobile communication terminal of the debtor.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Walker et al, US Patent No. 6,327,348 B1.

Based on the same analysis as per claims 1-5 above, *Foladare* meets all the limitations cited by claim 6, except that he does not specifically describe maintaining a database of merchant/service provider accounts at the authorization center for the purpose of further authentication/authorization of a requested transaction or service access.

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Walker discloses a similar authorization control system for transactions involving debit/credit card/charge accounts, wherein merchant/service provider accounts are maintained in a database and identification information from those accounts would be part of the initial authorization request and subsequent authentication/authorization process (Figs 4, 6, related description; Col 9, lines 18-30). *Walker* teaches that each transaction to be authenticated and authorized should comprise unique merchant information as well as unique user information, because each such element may be used in the authentication/authorization process, as well as subsequent account reconciliation and record keeping.

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to use such merchant/service provider identification data in a system inspired by *Foladare* and *Walker*, for the purpose of providing an even stronger authentication mechanism: only registered merchants/service providers and registered users may be cleared for transactions. Such a system would meet all the limitations of claim 6, namely:

An accounting apparatus as defined in claim 5 further comprising:

*a facility database registering the information of service presentation facility; and
facility authentication means,*

*wherein said accounting authentication control means further receives a facility ID
information for identifying the facility, through the open information communication line,*

*wherein said facility authentication means identifies the facility by comparing a facility ID
information registered in said facility database and the facility ID information received from
said accounting authentication control means, and*

wherein said mobile communication authentication means

*requests connection to the mobile communication terminal of the debtor registered in the
member database, when the facility ID and member ID are authenticated by said facility
authentication means and said basic authentication means.*

Conclusion

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8494 for regular communications and 703-746-8494 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL
June 10, 2003


JOHN W. HAYES
PRIMARY EXAMINER